

C. REMARKS

This Amendment is filed concurrently with a RCE and is in response to the Office Action dated April 2, 2003, in which claims 1-7 and 9-35 were rejected. With this Amendment, claims 1, 15 and 27 are amended. With this Amendment, claims 1-7 and 9-35 are presented by the Applicant for reconsideration and allowance.

**I. REJECTION OF CLAIMS 1, 4-5, 7-15, 18-19, and 21-26
UNDER 35 U.S.C. § 102(e)**

Section 1 of the Office Action rejected claims 1, 4-5, 7-15, 18-19, and 21-26 under 35 U.S.C. § 102(e) as being anticipated by Rohrer (U.S. Pat. No. 6,431,997). Claim 8 was previously cancelled without prejudice. Claims 1 and 15 are independent claims, and claims 4-5, 7 and 9-14, and 18-19 and 21-26 depend from independent claims 1 and 15, respectively. Independent claims 1 and 15 are amended to more clearly set forth the invention and are now believed to be patentably distinguishable over the cited prior art.

a. Claims 1, 4, 5, 7 and 9-14:

Independent claim 1, as amended, recites a putter head including a toe portion, a heel portion, a generally vertically extending wall, and a single, one-piece insert. The wall has a front strike face, a rear portion, an upper layer, and a lower layer. The upper layer, the lower layer and the rear portion each extend from the heel portion to the toe portion to define a recess that rearwardly extends into the wall from the strike face. The rear portion of the wall is formed with variable thickness thereby providing the recess with a variable rearward depth. The insert substantially fills the recess and is connected to the wall. The insert has a front facing surface, a top surface, a bottom surface and a rear surface. Generally the entire surface area of the front facing surface of the insert is exposed. The top and bottom surfaces are

substantially covered by the wall, and the front facing surface of the insert is substantially coplanar with the front strike face.

Rohrer does not disclose, teach or suggest the putter head of claim 1, as amended. In particular, Rohrer does not disclose, teach or suggest a putter head including a generally vertically extending wall having a recess, and a single, one-piece insert substantially filling the recess, wherein generally the entire surface area of a front facing surface of the insert is exposed and the front surface is substantially coplanar with the strike face. In contrast, Rohrer discloses several embodiments of club heads intended to be configured to correct distance loss due to mishits.

None of the embodiments disclosed or taught by Rohrer teach, suggest or disclose the combination of elements and limitations of claim 1, as amended. Most of the embodiments disclosed by Rohrer, including the embodiments of FIGS. 5-8 and 11-15, include a plurality of inserts connected to the clubhead body, and not a single, one-piece insert. The remaining embodiments, including the embodiments of FIGS. 9A, 9B, 10A, and 10B, do not include an insert having a front facing surface, wherein generally the entire surface area of the front facing surface is exposed. Further, the remaining embodiments do not include an insert having a front facing surface that is substantially coplanar with the strike face. In particular, the embodiments of FIGS. 9A, 9B, 10A, 10B of Rohrer include inserts which do not have a front facing surface that is coplanar with strike face, and these embodiments do not include a front facing surface wherein generally the entire surface area of the front facing surface of the insert is exposed. Rather, a substantial portion of the front facing surface of the insert of the embodiments of FIGS. 9A, 9B, 10A and 10B of Rohrer, is covered by multiple lateral face bars. Therefore, the front facing surface of the insert is not coplanar with the strike face, and a large portion of the front facing surface of the insert of these embodiments is not exposed.

Even if one ignored FIG. 9A and focused solely on FIG. 9B, the limitations of claim 1, are still not met, either the embodiment of FIG. 9B has more than one insert, which is

outside of the single, one-piece insert limitation of claim 1, or, as stated above, generally the entire front facing surface of the insert is not exposed and the front facing surface is not coplanar with the strike face. Further, even if one did not consider the faceplate or coverplate of the embodiment of FIG. 6 of Rohrer to be a separate insert, the embodiment of FIG. 6 would then not include an insert having a front facing surface that is exposed and is coplanar with the front striking surface.

None of the teachings or the disclosure of Rohrer discloses, teaches or suggests the limitations of claim 1, as amended. Accordingly, it is respectfully submitted that claim 1, as amended, overcomes the rejection based upon Rohrer and is believed to be in condition for allowance. Claims 4, 5 and 7-14 depend from claim 1 and are believed to be patentable over Rohrer for at least the same reasons.

b. Claims 15, 18, 19 and 21-26:

Independent claim 15, as amended, recites a putter head including a generally vertically extending wall and only one insert. The generally vertically extending wall has a front strike face and a rear surface. The wall has an insert region at the strike face defining a rearwardly extending recess of varying rearward depth. The insert is castably formed in the recess of the insert region. The insert has a front surface and a variable rearward depth to substantially fill the recess. The insert contacts the insert region of the wall. Substantially the entire surface area of the front surface of the insert is substantially coplanar with the front strike face.

Rohrer does not disclose, teach or suggest the putter head of claim 15, as amended. In particular, Rohrer does not disclose, teach or suggest a putter head including a generally vertically extending wall having a front strike face and an insert region at the strike face defining a recess, and only one insert castably formed into the insert region and substantially filling the recess, wherein substantially the entire surface area of the front facing surface of the insert is substantially coplanar with the front strike face.

None of the embodiments disclosed or taught by Rohrer teach, suggest or disclose the combination of elements and limitations of claim 15, as amended. As discussed above with reference to claim 1, most of the embodiments disclosed by Rohrer, including the embodiments of FIGS. 5-8 and 11-15, include a plurality of inserts connected to the clubhead body. The remaining embodiments, including the embodiments of FIGS. 9A, 9B, 10A, and 10B, do not include an insert having a front facing surface, wherein substantially the entire surface area of the front facing surface is substantially coplanar with the strike face. Rather, a substantial portion of the front facing surface of the insert of the embodiments of FIGS. 9A, 9B, 10A and 10B of Rohrer, is not coplanar with the strike face.

Even if one ignored FIG. 9A and focused solely on FIG. 9B, the limitations of claim 15, are still not met, either the embodiment of FIG. 9B has more than one insert, which does not meet the only one insert limitation of claim 15, or substantially the entire surface area of the front facing surface of the insert is not coplanar with the front strike face. Further, even if one did not consider faceplate or coverplate of the embodiment of FIG. 6 of Rohrer to be a separate insert, the embodiment of FIG. 6 would then not include an insert wherein substantially the entire surface area of the front facing surface of the insert is coplanar with the front striking surface.

Rohrer does not teach, suggest or disclose the limitations of claim 15, as amended. Accordingly, it is respectfully submitted that claim 15, as amended, overcomes the rejection based upon Rohrer and is believed to be in condition for allowance. Claims 18, 19 and 21-26 depend from claim 15 and are believed to be patentable over Rohrer for at least the same reasons.

II. REJECTION OF CLAIMS 6 AND 20 UNDER 35 U.S.C. § 103(a) AS BEING UNPATENTABLE OVER ROHRER '997 IN VIEW OF OFFICIAL NOTICE

Section 2 of the Office Action rejected claims 6 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Rohrer '997 in view of Official Notice. Claim 6 depends

from currently amended independent claim 1, and claim 20 depends from currently amended independent claim 15. It is respectfully submitted that claims 6 and 20 are patentable over Rohrer '997, including Official Notice, for at least the reasons stated above, with respect to independent claims 1 and 15.

III. REJECTION OF CLAIMS 2 AND 16 UNDER 35 U.S.C. § 103(a) AS BEING UNPATENTABLE OVER ROHRER '997 IN VIEW OF FISHER

Section 3 of the Office Action rejected claims 2 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Rohrer '997 in view of Fisher (U.S. Pat. No. 6,270,422). Claim 2 depends from currently amended independent claim 1, and claim 16 depends from currently amended independent claim 15.

Fisher discloses golf putter with trailing weighting and aiming members including a sweet-spot indicating index line. Fisher does not disclose, teach or suggest an insert disposed in or attached to the front strike face of the putter head.

It is respectfully submitted that neither Rohrer nor Fisher, alone or in combination, teach, suggest or disclose the combination of elements and limitations of independent claim 1, or independent claim 15. In particular, neither Rohrer nor Fisher teach, suggest or disclose a putter head including a generally vertically extending wall having a recess, and a single, one-piece (or only one) insert substantially filling the recess, wherein generally the entire surface area of a front facing surface of the insert is substantially coplanar with the strike face. Accordingly, because claims 2 and 16 depend from claims 1 and 15, respectively, it is respectfully submitted that claims 2 and 16 are patentable over Rohrer in view of Fisher for at least the same reasons.

IV. REJECTION OF CLAIMS 3, 17 AND 27-35 UNDER 35 U.S.C. § 103(a) AS BEING UNPATENTABLE OVER PRIOR ART AS APPLIED IN CLAIMS 1 AND 15 IN VIEW OF GRIM, JR.

Section 4 of the Office Action rejected claims 3, 17 and 27-35 under 35 U.S.C. § 103(a) as being unpatentable over Rohrer in view of Grim, Jr. (U.S. Pat. No. 5,551,694). Claim 3 depends from currently amended independent claim 1, and claim 17 depends from currently amended independent claim 15. Claim 27 is currently amended to more clearly set forth the invention and are now believed to be patentably distinguishable over the cited prior art. Claims 28-35 depend from amended claim 27.

Grim, Jr. discloses a golf putter having a plurality of sound-generating tines formed into the club head. Grim, Jr. does not disclose an insert disposed in, or attached to, the front strike face of the club head.

It is respectfully submitted that claims 3 and 17 are patentable over the prior art as applied in claims 1 and 15, and Grim, Jr., for at least the reasons stated above, with respect to independent claims 1 and 15.

Claim 27, as amended, recites a putter head including a toe portion, a heel portion, a generally vertically extending wall, a rearwardly extending recess defined into a strike face of the wall, an insert, and a sole portion. The wall extends from the toe portion to the heel portion. The wall has a front strike face and a rear surface. The recess has a varying rearward depth. The insert is formed of a first material. The insert substantially fills the recess and connects to the wall. The sole portion rearwardly extends from a lower portion of the wall. The lower portion has only one elongate through-sole slot. The through-sole slot is disposed rearward of the insert and is substantially parallel to the strike face.

It is respectfully submitted that neither the prior art as applied to claims 1 and 15, including Rohrer, nor Grim, Jr., alone or in combination, teach, suggest or disclose the combination of elements and limitations of independent claim 27, as amended. In particular,

neither Rohrer nor Fisher teach, suggest or disclose a putter head including a generally vertically extending wall having a recess of varying rearward depth, and an insert formed of a first material and substantially filling the recess, wherein only one elongate through-sole slot is disposed rearward of the insert and substantially parallel with the strike face. In contrast, Grim, Jr. discloses a putter head having two or more tone-generating tines. Independent claim 27 is amended to recite only one through-sole slot in the sole portion of the putter head, rearward of the insert.

Accordingly, it is respectfully submitted that claim 27, as amended, overcomes the rejection based upon the prior art as applied to claims 1 and 15, including Rohrer, in view of Grim, Jr., and is believed to be in condition for allowance. Claims 28-35 depend from claim 27 and are believed to be patentable over Rohrer in view of Grim, Jr. for at least the same reasons.

VI. CONCLUSION

Applicant respectfully requests reconsideration of claims 1-7 and 9-35. Applicant believes that the present application is now in condition for allowance. Favorable reconsideration under 37 C.F.R. § 1.112 is respectfully requested. The Examiner is invited to telephone the undersigned at (847) 472-6104 to discuss any issues in this case in order to advance the prosecution thereof.

Respectfully submitted,

Date 2 July 2003
Wilson Sporting Goods Co.
8700 W. Bryn Mawr Avenue
Chicago, IL 60631

By Terence P. O'Brien
Terence P. O'Brien
Attorney for Applicants
Registration No. 43,840

Telephone: (847) 472-6104
(773) 714-6498

Facsimile: (773) 714-4557